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| APPLICATION NO.                   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------|-------------|----------------------|---------------------|------------------|
| 10/559,843                        | 12/07/2005  | Christian Holz       | 64627(51994)        | 1944             |
| 21874                             | 7590        | 03/20/2008           | EXAMINER            |                  |
| EDWARDS ANGELL PALMER & DODGE LLP |             |                      | WACHTEL, EMILY L    |                  |
| P.O. BOX 55874                    |             |                      | ART UNIT            | PAPER NUMBER     |
| BOSTON, MA 02205                  |             |                      | 3767                |                  |
| MAIL DATE                         |             | DELIVERY MODE        |                     |                  |
| 03/20/2008                        |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/559,843             | HOLZ, CHRISTIAN     |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | EMILY WACHTEL          | 3767                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 December 2005.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-8 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>December 07, 2005</u> .                                       | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the instant case the Abstract exceeds 150 words in length.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1, is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites the limitation "the controllable actuating organs" in line 10. There is insufficient antecedent basis for this limitation in the claim.

6. Regarding claim 1, the word "means" is preceded by the word(s) "controllable actuating" in an attempt to use a "means" clause to recite a claim element as a means for performing a

specified function. Where means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and “equivalents thereof” that correspond to the recited function. Means plus function language is interpreted according to 35 U.S.C. 112, sixth paragraph (MPEP 2105). However, what is disclosed is means for actuating the controllable organs. Regarding claim 5, no structure or material is disclosed as the means for detecting the position of the controllable actuating organs.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 5, and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Slavik et al. (U.S. Patent 4,551,134).

With regard to claim 1, Slavik et al. teaches a system for metering and delivering a liquid medium, in particular for enteral nutrition in medical applications (Fig. 1 device 40, is capable of use in enteral nutrition), including a storage container having a certain volumetric capacity (Fig. 1 volumetric container 52) and a supply device (Fig. 1 supply device 42) and a discharge device (Fig. 1 discharge device 56) for the medium, whereby the supply and discharge of the medium into and out of the storage container is effected by the force of gravity (gravity necessarily affects flow from 42 into 52), characterized by said system further including a detecting device for determining at least a lower and at least an upper filling level of the medium in the storage

container and for outputting appropriate detection signals (detecting device is equivalent to light source 92 and photosensor 94 for determining a lower filling level, Fig. 2a, Col. 5 lines 65-67, and light source 96 and sensor 98 for determining an upper filling level, Fig. 2a, Col. 6 lines 3-5, microcomputer 100 receives input from the photosensors, Col. 6 lines 20-21), and controllable actuating means for closing or opening the supply device or the discharge device (Fig. 1 jaw 82 and 86 close and open the discharge device as controlled by microcomputer 100, Col. 6 lines 23-36), respectively, said detection signals output from the detecting device are supplied to a control unit for supplying setting signals (Col. 6 lines 20-36) to the controllable actuating organs (Fig. 1 jaws 82 and 86) according responsive to a given program sequence in dependence on the detection signals (Col. 6 lines 20-36).

With regard to claim 2, Slavik et al. teaches the detecting device comprises at least one pair of diode measuring units spaced from each other in the direction of the gravitational force in correspondence with the upper and lower filling level (Fig. 2a diodes are taken as photosensors 94 and 98).

With regard to claim 3, Slavik et al. teaches the diode measuring device associated with the upper filling level is arranged in such a manner as to prevent scanning of the inflowing medium stream (Fig. 2A and 2B fluid enters storage chamber 52 through conduit 70, the diodes to not scan the inflowing medium through conduit 70 just the level of fluid in storage chamber 52).

With regard to claim 5, Slavik et al. teaches position detecting means which detect the position of the controllable actuating organs (Fig. 3 sensor 104 and switch 102 signal microcomputer 100 as to the position of the jaws, Col. 6 lines 23-35).

With regard to claim 7, the controller 10 and microcomputer 100 are integrated into the system (Col. 6 lines 17-19).

With regard to claim 8, Slavik et al teaches the detection signals from the detecting device and setting signal from the actuating organs are through micro computer 100 to controller 10 (Col. 6 lines 17-35). Such signals are applicable, capable of being applied to, an interface for connection to an external control unit.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slavik (U.S. Patent 4,551,134) as applied to claim 1 above, and further in view of Sealfon (U.S. Patent 4,921,480).

With regard to claim 4, Slavik et al. teaches system for metering and delivering a liquid substantially as claimed. Slavik et al. teaches controllable actuating member 82 and 86 to be controlled by motor 84. Slavik et al. does not teach controllable actuating organs to be closed or open by a solenoid or stepping motor. However, Sealfon teaches a metering device for a gravity feed intravenous fluid delivery system which includes tubing 22 which is opened and closed via solenoid clamp 32 (Fig. 1, Col. 2 lines 56-58). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use solenoid clamps in the metering

device of Slavik et al. because Sealfon teaches such to be art effective means for opening and closing tubing to meter flow through a delivery device.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slavik (U.S. Patent 4,551,134) as applied to claim 1 above, and further in view of Schmidt (U.S. Patent 4,262,668).

With regard to claim 6, Slavik et al. teaches system for metering and delivering a liquid substantially as claimed. Slavik et al. does not disclose a ventilating device. However, Schmidt teaches a device for controlling intravenous solution which includes ventilating filters so that air or gas is released to the atmosphere and is not passed to the patient (Col. 2 lines 19-22). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a ventilating device in the system of Slavik et al. because Schmidt teaches ventilating to be beneficial in that it prevents undesired air or gas from reaching the patient.

### *Inventorship*

12. In view of the papers filed July 25, 2006, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by the addition of inventors Ignacio Larraín and Michael Jedwab.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILY WACHTEL whose telephone number is (571)270-3648. The examiner can normally be reached on Monday through Thursday 7:30 AM to 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Emily Wachtel/  
Examiner, Art Unit 3767  
/Kevin C. Sirmons/  
Supervisory Patent Examiner, Art Unit 3767